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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/626,359

07/23/2003

Scott G. Eagle

10005.000420

1220

31894 7590 03/09/2007
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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/626,359	Applicant(s) EAGLE ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 and 42-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-20 and 42-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-20 and 42-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darby et al. (2003/0126597) further in view of Official Notice.

Regarding claims 17 and 18, Darby teaches receiving a first message from a source, the message including textual information about message delivery by the source and receiving a second message from the source, the second message including a source indicator to dissociate the second message from a publisher of a web page being displayed along with the second message (see fig. 2 & 3, [0013] – [[0031])). Darby does not explicitly teach where in the first message includes information regarding a term of the license agreement to allow a source to deliver messages to a client computer. However official notice is taken that is old and well known in the art of advertisement for end-user to agree to receive advertisement. For instance an end-user is required to click on a license agreement to agree to receive advertisements in exchange for access privileges before advertisements are received. It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention was made to make the end-user to

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agree to receive advertisements (as opposed to just displaying advertisements to the end-user) to ensure that the end-user understands the conditions for having the access privileges.

Regarding claims 19-45, Darby teaches wherein the source indicator includes a logo; the second message includes an advertisement; the first and second messages are displayed in separate windows; wherein the at least the second message is displayed in a window having adjacent icons that are activated differently, etc (see fig. 2&3 and [0046] – [0062]).

Regarding claim 46, Darby teaches delivering a second window to the consumer, the second window being delivered by the source and containing information explicitly dissociating the source from a publisher of a web page currently displayed with the second message (see fig. 2 & 3, [0013] – [[0031]). Darby does not explicitly teach delivering a first window containing a license agreement to allow a source to deliver messages to a client computer. However, official notice is taken that is old and well known in the art of advertisement for a source to send a license agreement first so the end-user can agree to receive and advertisement. For instance an end-user is required to click on a license agreement, to agree to receive advertisements in exchange for access privileges before advertisements are downloaded. It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention was made to make the end-user to agree to receive advertisements (as opposed to just displaying advertisements to the end-user) to ensure that the end-user understands the conditions for having the access privileges.

Regarding claim 47-50, Darby teaches the second window comprises textual information; a window including a source indicator indicating that the window is delivered by the source; the

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indicator comprising a logo; second window comprises a pop-up windows (see fig. 2&3 and [0046] – [0062]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ishii (US 2002/0178443) teaches providing the source of the displayed advertisement.

Vrieling (US2002/0131772) teaches displaying the source of a program displayed or viewed.

Berberet et al. (US 2003/0226150) teaches providing license of agreement to display advertisement to an end-user.


Fuller et al. (US 6,216,112) teaches terms of agreement to display advertisement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RETTA YEHDEGA
PRIMARY EXAMINER